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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,948	01/23/2006	Zaihui Zhang	540057.418USPC	6733

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC  
701 FIFTH AVE  
SUITE 5400  
SEATTLE, WA 98104

EXAMINER
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STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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06/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/521,948	<b>Applicant(s)</b> ZHANG ET AL.	
	<b>Examiner</b> Laura L. Stockton	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,14-20,22-24,27,29 and 77-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,14-20,22-24,27,29 and 77-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>February 25, 2009</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

**Claims 1, 3-6, 14-20, 22-24, 27, 29 and 77-82 are pending in the application.**

***Election/Restrictions***

Applicant's election with traverse of Group I (claims 1-24, 27, 29 and 77-82 - drawn to products of formula (1)) in the reply filed on August 22, 2008 was acknowledged in the previous Office Action. The requirement was deemed proper and therefore made FINAL in the previous Office Action.

Claims 30, 31, 34-37, 39-52 and 83-89 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 22, 2008. Claims 30, 31, 34-37,

39-52 and 83-89 have been cancelled per the Amendment filed February 25, 2009.

***Information Disclosure Statement***

The Examiner has considered the Information Disclosure Statement filed on February 25, 2009.

Rejections made in the previous Office Action that do not appear below have been overcome by Applicant's amendments to the claims. Therefore, arguments pertaining to these rejections will not be addressed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and

use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 78 and 82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is a new matter rejection. No support could be found in the specification or the originally filed claims for the added compounds to claims 78 and 82. Applicant did not state where in the specification {page number(s) and line number(s)} support could be found for the changes to the claims. Applicant should specifically point out the support for any amendments. See M.P.E.P. §§ 714.02 and 2163.06. Therefore, the claims lack written description as such.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-6, 14-20, 22-24, 27, 29 and 78-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 15, 23, 24, 27 and 29, there is a valence problem when any of  $R^1$ ,  $R^2$  and  $R^3$  represents a sulfonyl, which is divalent, when a monovalent substituent is required.

In claim 78, there are species in claim 78 that are not embraced by currently amended claim 23. See, for instance, the first species listed.

### ***Response to Arguments***

Applicant's arguments filed February 25, 2009 have been fully considered. Applicant argues that

"sulfonyl" conventionally refers to a class of monovalent groups in which one skilled in the art readily recognize. Applicant's argument has been considered but has not been persuasive. The claimed compounds should not have dangling valences. Claims of the "dangling valence" type in which only the portion of the structure responsible for the activity is defined in the claim are indefinite because the claims are of indeterminate in scope and generally broader than any possible supporting disclosure. Ex parte Diamond, 123 USPQ 167 (POBA 1959).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 23 is rejected under 35 U.S.C. 102(a) as being anticipated by CA Registry No. 385424-29-3 {indexed in the Registry file on STN January 22, 2002}

The compound of CA Registry No. 385424-29-3 is embraced by the instant claimed invention. Therefore, the cited prior art anticipates the instant claimed invention.

### ***Response to Arguments***

Applicant's arguments filed February 25, 2009 have been fully considered. Applicant argues that the compound of CA Registry No. 385424-29-3 is not embraced by currently amended claim 23 because the 2,4-dihydroxyl-3-methylphenyl group does not fall within the definition of instant variable R<sup>3</sup>. In response, Applicant's argument is not persuasive. The 2,4-dihydroxyl-3-methylphenyl group is found on the 3-



position of the pyrazole ring, which is the position of the instant  $R^2$  variable, not  $R^3$ . The instant  $R^2$  variable can represent "aryl". The instant specification (page 9) defines "aryl" as follows:

**"Aryl" refers to a phenyl or naphthyl radical. Unless stated otherwise specifically in the specification, the term "aryl" or the prefix "ar-" (such as in "aralkyl") is meant to include aryl radicals optionally substituted by one or more substituents selected from the group consisting of alkyl, alkoxy, hydroxy, halo, haloalkyl, haloalkoxy, amino and carboxy as defined herein.**

Therefore, since the aryl can be substituted with substituents such as alkyl and hydroxy, the above cited compound does anticipate currently amended claim 23. The rejection is deemed proper and therefore, the rejection is maintained.

Claims 1, 4, 5, 14-16, 23 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by:

- a) the compound of CA Registry No. 302575-58-2  
{indexed in the Registry file on STN November 13,  
2000};
- b) Gour et al. {WO 2001/053331} - see Compound 266  
in Figure 15BD (Sheet 90/201) and page 7 of the  
specification;
- d) Gorbulenko et al. {CA 122:290759, 1995} - see,  
for example, the compound of CA Registry No. 136507-02-  
3; or
- e) Nawwar et al. {CA 120:164052, 1994} - see the  
compound of CA Registry No. 153259-09-7;

Each of the above cited prior art disclose at least one compound that is embraced by the instant claimed invention. Therefore, the instant claimed invention is anticipated by each of the above cite prior art.

***Response to Arguments***

Applicant's arguments filed February 25, 2009 have been fully considered. Applicant argues that the compound of CA Registry No. 302575-58-2 is not embraced by currently amended claim 23 because the 2,4-dihydroxyl-3-methylphenyl group does not fall within the definition of instant variable  $R^3$ . In response, and as stated above, Applicant's argument is not persuasive. The 2,4-dihydroxyl-3-methylphenyl group is found on the 3-position of the pyrazole ring, which is the position of the instant  $R^2$  variable, not  $R^3$ . The instant  $R^2$  variable can represent "aryl". The instant specification (page 9) defines "aryl" as follows:

**"Aryl" refers to a phenyl or naphthyl radical. Unless stated otherwise specifically in the specification, the term "aryl" or the prefix "ar-" (such as in "aralkyl") is meant to include aryl radicals optionally substituted by one or more substituents selected from the group consisting of alkyl, alkoxy, hydroxy, halo, haloalkyl, haloalkoxy, amino and carboxy as defined herein.**

Therefore, since the aryl can be substituted with substituents such as alkyl and hydroxy, the compound of

CA Registry No. 302575-58-2 does anticipate currently amended claim 23.

Applicant argues that Compound 266 in Figure 15BD of Gour et al. and the compound of CA Registry No. 136507-02-2 in Gorbulenko et al. are not embraced by currently amended claim 23 because the 2,4-dihydroxyl-3-methylphenyl group does not fall within the definition of instant variable R<sup>3</sup>. Applicant's argument is not persuasive for reasons stated above for the compound of CA Registry No. 302575-58-2.

Applicant argues that currently amended claim 77 does not list the compound of CA Registry No. 153259-09-7 found in Nawwar et al. {CA 120:164052, 1994}. In response, Applicant's argument is not persuasive since the compound of CA Registry No. 153259-09-7 is in fact listed in currently amended claim 77 on page 12, line 6 of the Amendment filed February 25, 2009.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/  
Laura L. Stockton  
Primary Examiner, Art Unit 1626  
Work Group 1620  
Technology Center 1600

June 4, 2009